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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/455,805	12/07/1999	SUSAN D. WOOLF	03797.78802	5591

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EXAMINER

NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 09/16/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

PR4

Office Action Summary	Application No. 09/455,805	Applicant(s) WOOLF ET AL.	
	Examiner Maikhanh Nguyen	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

P r i d f r Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disp sition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>10</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment A filed 06/18/2003 to the original application filed 07/12/1999; IDS filed 07/22/2003.
2. Claims 1-29 are currently pending in this application. Claims 1,10,16 and 18 have been amended; claims 21-29 have been added by Applicant. Claims 1, 10, 16, and 29 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Cassorla et al.** (U.S. 5,146,552 – filed 02/1990 as cited by IDS filed 10/24/2002) in view of **Applicant Admitted Prior Art (APA)**.

As to independent claim 16, Cassorla discloses a computer-readable storage medium comprising computer-executable instructions for performing steps comprising:

- annotating parts of a currently displayed page in accordance with movement of a user input device to indicate where on the currently displayed document page the annotations should appear (*The association of annotations with a particular context within the document*

exploits the fact that the writer in constructing an electronically published document has indicated the structure of the document by "marking up" the material and identifying major document elements such as chapters, sections, sub-sections, paragraphs, figures, etc.; col.2, lines 16-55); and

- storing annotations made in step (2) separate from the electronic document (*The record of such annotations or "place marks" can be stored within or separately from the published material. Annotations stored separately from the originally published document are associated by name with the document and can either be accessed by a particular individual reader and/or shared and exchanged between individuals with access to the same 'or copies of the' published electronic document for a variety of purposes; col.2, lines 16-55).*

Using the forwarding and backwarding functions of a web browser for switching among a plurality of WebPages is obvious.

Cassorla, However, is silent on "*displaying an electronic document page on a computer display device and permitting a user to move forward and backward among a plurality of document pages.*"

APA discloses:

- displaying an electronic document page on a computer display device and permitting a user to move forward and backward among a plurality of document pages (*Web browsers typically provide functions which permit a user to advance forward and backward among a series of related pages; Background; page 1, lines 17-22).*

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of APA with Cassorla because it would have provided the capability for switching among a plurality of web documents.

As to dependent claim 17, Cassorla discloses instructions for creating an opaque annotation that obscures annotated portions of the currently displayed document (*Fig. 1*).

As to dependent claim 18, Cassorla discloses instructions for creating a translucent annotation that does not completely obscure annotations portions of the currently displayed document, wherein the translucent annotation is generated by blending pixels from the currently displayed document with a highlighting pixel color (*several types of annotations... This type of annotation is typically accomplished by underlining, color "highlighting" or margin "flags" in material printed on paper; col. 4, lines 4-42*).

As to dependent claim 19, Cassorla discloses instructions for erasing portions of previously created annotations (*Fig. 1*).

As to dependent claim 20, Cassorla discloses a. in response to detecting that the user has moved to a different document page, retrieving previously stored annotations associated with the different document page; and b. displaying the annotations retrieved in step (a) on the different document page (*Fig. 5*).

Independent claim 1 is directed to a method for performing the computer-readable storage medium of claim 16, and is similarly rejected under the same rationale.

However, claim 1 further recites "selecting an annotation mode that permits the user to annotate the currently displayed document page."

Cassorla discloses selecting an annotation mode that permits the user to annotate the currently displayed document page (*The operating principle permits a reader of an electronically published document to create notes, bookmarks, or annotations and relate them to a particular location in the document; col.2, lines 16-55*).

As to dependent claim 2, Cassorla discloses the step of using opaque markings that obscure portions of the currently displayed document page (*Fig. 1*).

As to dependent claim 3, Cassorla discloses the step of using a translucent highlighting (highlighting) that does not completely obscure the annotated portions of the currently displayed document page (*col.6, lines 51-68*).

As to dependent claim 4, Cassorla discloses the step of blending pixels from the currently displayed document with a translucent color to produce a translucent annotation (*Several types of annotations... color, type style, etc. be recorded; col.4, lines 4-43*).

As to dependent claim 5 includes the same limitations as in claim 19, and is similarly rejected under the same rationale.

As to dependent claim 6, Cassorla does not explicitly disclose the step of using a stylus with a tablet computer system.

APA discloses the step of using a stylus with a tablet computer system (*tablet and stylus; Background; page 1, lines 23-27*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of APA with Cassorla because it would have provided the capability for allowing a user to add annotations and other markings to document pages.

As to dependent claim 7, Cassorla discloses the step of storing a separate stroke for each annotation, wherein each stroke corresponds to a continuous set of movement when the user input device is activated *(The record of such annotations or "place marks" can be stored within or separately from the published material. Annotations stored separately from the originally published document are associated by name with the document and can either be accessed by a particular individual reader and/or shared and exchanged between individuals with access to the same 'or copies of the' published electronic document for a variety of purposes; col.2, lines 17-44).*

As to dependent claim 8, Cassorla discloses moving to a different document page; retrieving previously stored annotations associated with the different document page; and displaying the retrieved annotations on the computer display device superimposed over the different document page *(Fig.3 and col.6, lines 51-68).*

As to dependent claim 9, Cassorla discloses the step of detecting a title change event in the document browser and, in response thereto, locating an annotation file corresponding to the different document page *(Fig.4).*

Independent claim 10 is directed to a system for performing the method of claim 1, and is similarly rejected under the same rationale.

As to dependent claims 11-12 include the same limitations as in claims 2-3, and are similarly rejected under the same rationale.

As to dependent claim 13, Cassorla discloses the computer software displays and stores erased annotations that remove previously made annotations on the currently displayed document page (fig.3).

As to dependent claim 14, Cassorla does not explicitly disclose a flat panel display, and wherein the computer input device comprises a stylus.

APA discloses a flat panel display, and wherein the computer input device comprises a stylus (*tablet and stylus; Background; page 1, lines 23-27*).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of APA with Cassorla because it would have provided the capability for allowing a user to add annotations and other markings to document pages.

As to dependent claim 15, Cassorla discloses upon detecting a title change event, previously stored annotations associated with a different document page and displays the previously stored annotations on the different document page (*Fig.3 and col.6, lines 51-68*).

Dependent claims 21, Cassorla discloses annotations are stored in a data structure as strokes (*col.2, lines 17-44*).

Dependent claim 22, Cassorla discloses each stroke includes a stroke width and coordinates indicating a trajectory of the stroke (*col.9, line 54-col.10, line 12*).

Dependent claims 23, 26 and 28, Cassorla discloses annotations are stored as a bitmap image (*col.4, lines 4-42*).

Dependent claim 24, Cassorla discloses annotation mode selection menu (*fig.2*).

As to independent claim 29, the rejection of claim 16 above is incorporated herein in full. Claim 29, however, further recites:

- determining an initial position of the annotation;
- determining a width and trajectory of the annotation; and

- displaying the annotation in an ink layer that is superimposed over and blended with pixels on the document page.

Cassorla discloses:

-determining an initial position of the annotation (*The association of annotations with a particular context within the document...uses relative position within the "finest" identified document element to fix the precise position of some annotations that the reader wants to pinpoint to a particular line or word position; col.2, lines 35-44*);

-determining a width and trajectory of the annotation (*Any annotations...can be edited by the user or deleted by the user...If the annotation served as a bookmark, then its type field would be changed to designate that function in the annotation string record; col.9, line 54-col.10, line 12*); and

-displaying the annotation in an ink layer that is superimposed over and blended with pixels on the document page (*col.4, lines 4-42*).

Response to Arguments

4. Applicant's arguments filed 07/22/2003 have been fully considered but they are not persuasive.

Applicant argues that "*the combination of Cassorla and Applicants's written description is improper... Cassorla cannot be properly combined with the cited portion of Applicants's written description.*" (Remarks, pages 9-10)

In response, the Examiner disagrees. Cassorla teaches “*a method for creating an annotation associated with a designated portion of an on-line book; col.10, lines 29-60*). For locating and displaying *an on-line book* (Web pages), a Web browser must be used. Therefore, the Examiner believes that the combination of Cassorla and the web browser’s functionality as admitted by Applicant is proper.

Applicant argues that “*Cassorla fails to teach or suggest, ‘storing a separate stroke for each annotation, wherein each stroke corresponds to a continuous set of movement when the user input device is activated.’”* (Remarks, page 11)

In response, the Examiner contends that the teachings of Cassorla “*The record of such annotations or “place marks” can be stored within or separately from the published material. Annotations stored separately from the originally published document are associated by name with the document and can either be accessed by a particular individual reader and/or shared and exchanged between individuals with access to the same ‘or copies of the’ published electronic document for a variety of purposes; col.2, lines 17-44*) reads-on the limitations as claimed by Applicant.

As to new claims 21-29, Applicant argues that “*Cassorla fails to teach or suggest the features of Applicant’s new claims 21-29*” (Remarks, p. 12)

In response, the Examiner believes that the combination of Cassorla and APA teaches all the limitations claimed by Applicant. How the combination meets the limitations and the reasons for combining the references are pointed out in the rejections above.

As to dependent claims, the arguments are not persuasive for reason as discussed above with regards to independent claims 1, 10, 16, and 29.

Conclusi n

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sidana	U.S Patent No. 6,571,295	issue dated: May 27, 2003
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Schilit et al.	U.S Patent No. 6,279,014	issue dated: Aug. 21, 2001
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Pacifici et al.	U.S Patent No. 6,230,171	issue dated: May 8, 2001
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Levine et al.	U.S Patent No. 5,680,626	issue dated: Oct. 21, 1997
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Levine et al.	U.S Patent No. 5,625,833	issue dated: Apr. 29, 1997
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Hirotsu et al. "Cmew/U - A Multimedia Web Annotation Sharing System", NTT Network Innovation Laboratories - Japan, IEEE, 1999, pages 356-359.

Kuo et al. "A Synchronization Scheme for Multimedia Annotation", Multimedia Information NETworking Laboratory, Tamkang University - Taiwan, IEEE, 1997, pages 594-598.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (703) 305-9792. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5403 for regular communications and (703) 308-5403 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Contact Information:

Any response to this action should be mailed to:

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Or fax to:

AFTER-FINAL faxes must be signed and sent to (703) 746-7238.

OFFICIAL faxes must be signed and sent to (703) 746-7239.

NON OFFICIAL faxes should be sent to (703) 746-7240.


All OFFICIAL faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday, Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the Office, e.g., Finance Division for fee charging, etc.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,

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Arlington, VA., Sixth Floor (Receptionist). All hand-delivered responses will be handled and entered by the docketing personnel. Please do not hand deliver responses directly to the Examiner.

Maikhanh Nguyen
September 7, 2003



SANJIV SHAH
PRIMARY EXAMINER